

Via E-File

PATENT APPLICATION
Docket: 14531.27.2.2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND
INTERFERENCES

In re application of)	
	Stephen G. Perlman)	
Serial No.:	09/557,196)	
	April 21, 2000)	Art Unit
)	2167
Confirmation No.:	6989)	
For:	SYSTEM AND METHOD FOR TUNING)	
	CHANNELS USING A CENTRAL)	
	POINT OF CONTROL)	
Examiner:	Chau T. Nguyen)	
Customer No.:	047973)	

REPLY BRIEF OF APPELLANT

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

On November 28, 2006, the Examiner mailed its Response to Appellant's timely filed Appeal Brief. This Reply Brief is being filed under the provisions of 37 C.F.R. § 41.41. This brief is being filed on Friday, January 26, 2007 and is therefore timely under 37 C.F.R. § 41.41.

ARGUMENT

I. Introduction

Appealed claims 1-19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kurtz (U.S. Patent No. 5,574,440) in view of Macrae *et al.* (U.S. Patent No. 6,745,391). In its Appeal Brief, Appellants explained that neither Kurtz nor Macrae teaches the claimed elements of 1) a tuner that is located at the central device to tune signals carrying non-scrambled programming, 2) a central device that uses EPG data to determine whether an incoming signal is carrying scrambled or non-scrambled programming, and 3) a central device that receives user input to select a channel that corresponds to a signal carrying programming. Appellants also argued that combining the teachings of Kurtz and Macrae is improper because such a combination is contrary to the very purpose of Kurtz to restoring the tuning capabilities of the peripheral devices.

Rather than addressing these arguments as set forth in Appellant's Appeal Brief, the Examiner's Response Brief merely contains naked citations to Kurtz and Macrae and conclusory statements that the prior art teaches the claimed elements. Consequently, the Examiner did not challenge Appellant's explanation of why the Examiner's citations to Kurtz and Macrae do not teach the elements as cited by the Examiner. The Examiner's conclusory statements and citations to the prior art taken out of context should be rejected and the Appeal should be sustained for the reasons set forth below.

II. The Examiner Has Not Established a *Prima Facie* Case of Obviousness for Any Claim

A. ***The Examiner Has Not Shown in the Prior Art a Central Device that Uses EPG Data to Determine Whether a Signal Is Carrying Scrambled or Non-scrambled Programming, or a Tuner Located at the Central Device as Required by All Claims***

As set forth in the Appeal Brief, all of the appealed claims require the central device to store EPG data. Importantly, the central device uses that EPG data to determine which signals are carrying scrambled programming, and which signals are carrying non-scrambled programming. All of the claims also require a tuner to be located at the central device. The tuner located at the central device is used to tune signals carrying non-scrambled programming, thereby removing the need for other electronic devices to tune those signals.

a) **The Examiner Has Not Shown that Macrae or Kurtz Teaches Using EPG Data Stored at the Central Device To Determine Whether a Programming Signal is Scrambled or Non-scrambled**

The Examiner first attacks Appellant's argument that Kurtz and Macrae do not teach using EPG data stored at the central device to determine whether a programming signal is scrambled or non-scrambled by arguing that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." (Response Brief, at p. 12 (citing *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)).) These cases, however, are inapposite to the present case.

In *Keller* claims for a pacemaker using a digital timing mechanism were rejected as obvious over two references for pacemakers that used R-C timing units in light of the "Walsh" reference that used a digital timing mechanism in a heart stimulator. 208 USPQ at 878. The appellant attempted to overcome this obviousness rejection by showing that the Walsh reference did not disclose a pacemaker. *Id.* at 882. The Court of Customs and Patent Appeals held that an

obviousness rejection based on multiple references can not be overcome by showing that a single reference did not teach the claimed element. *Id.* In other words, the applicant in *Keller* could not overcome the rejection by showing that the pacemaker element was not present in the Walsh reference because the examiner cited different references for the pacemaker element.

Merck & Co. regards claims for using a certain molecule as an antidepressant. 231 USPQ at 375-76. The Board rejected the claims as obvious because a prior art molecule that is chemically-related to the claimed molecule was a known antidepressant. *Id.* at 378. The Board also relied on various other prior art articles that taught that the precise differences between the claimed molecule and the prior art molecule would not change the biological activity of the claimed molecule to find that one of ordinary skill in the medicinal chemicals art would find obvious the antidepressant qualities of the claimed molecule. *Id.* at 379. The applicant argued that one of the cited prior art references read *in isolation* taught away from using the claimed molecule as an antidepressant. *Id.* at 380. The court held that a prior art reference used in an obviousness rejection “must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole.” 231 USPQ at 380.

In the present case the Examiner cited Kurtz as teaching a central device that distinguishes between scrambled and non-scrambled programming (Final Office Action, at 3), and cited Macrae as teaching the use EPG data to determine whether programming is scrambled or non-scrambled (Final Office Action, at 4). The Examiner then combined these references arguing that the combination teaches a central device that uses EPG data to determine whether programming signals are scrambled or non-scrambled. In the Appeal Brief, however, Appellant demonstrated in great detail that Kurtz does teach a central device that distinguishes between scrambled and non-scrambled programming. (Appeal Brief, at pp. 15-20.) Appellant also

demonstrated that Macrae does not use EPG data to determine whether a programming signal is scrambled or non-scrambled. (Appeal Brief, at pp. 25-26.) Because neither Kurtz nor Macrae teaches these respective specific elements *for which the examiner cites* them, they can not be combined to arrive at the element of a central device that uses EPG data to determine whether programming signals are scrambled or non-scrambled. The Examiner's citations to *Keller* and *Merck & Co.* simply are inapposite the present case.

The Examiner does not address the arguments set forth in the Appeal Brief that the switch of Kurtz does not distinguish between scrambled and non-scrambled signals, and that Macrae does not teach using EPG data to determine whether programming signals are scrambled or non-scrambled. Instead, the Examiner continues to argue in conclusory fashion that "by indicating or pointing out [with the green and red LEDs] what type of the signal [sic] means determining whether the signal is scrambled or non-scrambled." (Response Brief, at p. 13.) The Examiner does not address Appellant's argument that the LEDs of Kurtz merely indicate a source of programming but do not indicate whether that source contains scrambled or non-scrambled programming. (See Appeal Brief, at pp. 18-20.) It is technologically impossible for the LEDs of Kurtz to determine whether the programming signal is scrambled or non-scrambled because the signal does not pass through any circuitry up stream from the LEDs. (See *id.*) Further, the Examiner does not address Appellant's argument that the Source A and Source B of Kurtz both contain all the programming (both the premium and non-premium programming), the only difference being that the premium programming has been descrambled by the set top box in Source B, but not descrambled in Source A. (See Appeal Brief, at pp. 16-18.) For at least these reasons, the Board should reject the Examiner's conclusory statements and citations to Kurtz as teaching determining whether a signal is scrambled or non-scrambled.

The Examiner also continues to rely solely on Macrae as teaching use of EPG data to determine whether a programming signal is scrambled or non-scrambled. (Response Brief, at pp. 11, 14.) The Examiner's argument on this issue is the following sentence (stated twice in the Response Brief): "Macrae et al. discloses a television schedule configured with an EPG database for detecting whether a program signal is scrambled or unscrambled (Abstract and col. 1, line 54 – col. 2, line 10)." (Response Brief, at p. 14; *see also id.* at p. 11-12.)

While the Examiner has expanded his citation to Macrae from the Final Office Action to now include col. 1, line 58 – col. 2, line 10, the Examiner's conclusory statement that Macrae teaches using EPG data to determine whether programming is scrambled or non-scrambled is still mistaken. To the contrary, the passage cited by the Examiner expressly teaches that "[a] processor in the system maintains the EPG database with program listings for the regularly unscrambled channels. The *processor updates the EPG database when one of the regularly scrambled television channels is now unscrambled.*" (Macrae, at col. 1, ll. 62-66 (emphasis added).) Thus, this passage lends additional support to Appellant's argument that Macrae teaches updating the EPG database *after* a determination has been made of whether programming is scrambled or non-scrambled. Because the EPG database is updated *after* the scrambled/non-scrambled determination is made, the EPG data can *not* be used to make that determination in the first instance. The Examiner's reliance on this new passage simply is misplaced and should be rejected.

b) The Examiner Has Not Shown a Tuner Located at the Central Device

The Examiner argues that Kurtz teaches a tuner located at the central device, and that such a tuner "is an inherent feature of the central device of the applicant's invention." As regards the Kurtz reference, the Examiner argues that "where the signal source selected is a non-premium (non-scramble) channel input, the viewer is provided the use of all the various built-in

programming (tuner) [sic] and television receiver [sic] to tune the signal before being displayed.” First, the Examiner implies that “the various built-in programming” discussed in Kurtz is located at the central device. This implication is wrong. Kurtz teaches that “[w]here the signal source selected is a non-premium channel input, the viewer is provided the use of all the various built-in programming and viewing features *of the video recorder and/or television receiver*.” (Col. 3, ll. 58-61.) The video recorder and/or television receiver are peripheral devices, not the central device. The Examiner also suggests that these “programming and viewing features of the video recorder and/or television receiver” include a tuner. Kurtz, however, teaches that the tuners of the VCR and television *enable* use of the “built-in programming and viewing features[,]” such as programming the VCR to record a selected channel at a future time and a different channel at another time, providing picture in picture operations, or record one channel while watching another channel. (See Kurtz, at col. 2, ll. 14-29.) In any event, all of the “programming and viewing features” are expressly those of the VCR and television, and thus do not teach a tuner at the central device.

The Examiner also makes the following argument that a tuner located at the central device is “well-known in the art”:

Also, *it's well-known in the art* that either scrambled or non-scrambled signal [sic] must be tuned before being displayed, they have to be *tuned either by [sic] set top box, television, or [sic] any device*. Therefore signals must be tuned before being displayed [sic] is an inherent feature at the central device of the applicant's invention.

(Response Brief, at pp. 11-12 (emphasis added); see also *id.* at pp. 4 and 13.) The Examiner's own statement quoted above, however, exposes the flaw in his conclusory reasoning that because “signals must be tuned before being displayed” a tuner “is an inherent feature at the central device.” The Examiner effectively concedes that a *set top box or television* may be used to tune the channels, not the central device. Consequently, it is neither necessary nor inherent that the

central device must contain a tuner. Indeed, the Examiner's statement supports Appellant's argument that Kurtz teaches using the set top box to tune scrambled programming, and the television and/or VCR to tune non-scrambled programming. (See Appeal Brief, at pp. 20-23.) Nowhere does Kurtz teach a tuner located at the central device, and the Examiner's argument that such a tuner is well-known in the art is both unsupported by any evidence and contradicted by the Examiner's own statement.

B. The Prior Art Cited by the Examiner Does Not Disclose a Central Device that Receives User Input Wherein the User Input Selects a Channel that Corresponds to a Signal Carrying Programming as Required by Claims 1-4, 15, and 18

In response to Appellant's argument that the prior art does not teach a central device that receives user input that selects a channel corresponding to a signal carrying programming, the Examiner argues that the "switching apparatus 10 (the central device) is employed with an entertainment installation having a cable signal passing through a cable convert box (descrambler), and user [sic] can use a remote control to select a channel." (Response Brief, at p. 15.) It is unclear whether the Examiner is arguing that a user can use a remote control to select a channel at the cable convert box (descrambler), or at the switching apparatus 10. Neither interpretation, however, teaches the element of both receiving input and selecting a channel at the central device.

First, if the Examiner is arguing that a user can use a remote control to select a channel at the cable convert box (descrambler), then the channel selection is occurring at the peripheral cable convert box (descrambler) and not at the central device. Consequently, this argument does not satisfy the element of selecting a channel ***at the central device***.

Second, if the Examiner is arguing that a user can use a remote control to make a selection at the switching apparatus 10, then the selection is of a Source, and not of a channel.

Kurtz clearly teaches that the switching apparatus 10 merely “flip-flops” between “sources” of programming. (Kurtz, at col. 12, ll. 40-47.) Each source contains multiple channels. (See *id.* at col. 5, ll. 57-61; *id.* at Figure 2, parts 22-27.) Nothing in Kurtz teaches selecting a specific channel contained in Source A or Source B at the central device. Thus, the switching apparatus 10 merely switches between sources, and is not capable of receiving input to select a specific channel that corresponds to a signal carrying programming.

C. Kurtz Can Not Be Combined with Macrae to Arrive at the Claimed Invention Because Such a Combination Is Contrary to the Purpose of Kurtz

The Examiner argues that it is proper to combine Kurtz and Macrae to make an obvious rejection of the appealed claims because Kurtz and Macrae “are analogous art.” (Response Brief, at p. 14.) The Examiner, however, ignores the fact that combining Kurtz and Macrae to make the claimed invention is directly contrary to the purpose of Kurtz.

The goal and purpose of the Kurtz invention is to route non-scrambled programming directly to the VCR and television to be tuned, thereby bypassing the tuning function of the converter box. (See Kurtz, at col. 1, l. 59 – col. 2, l. 29, and col. 4, ll. 45-64.) Routing the non-scrambled programming directly to the VCR and television to be tuned those devices, as opposed to being tuned by some other device, restores the “built-in programming and viewing features” of those devices as discussed above. (See *id.* at col. 4, ll. 59-64.) Thus, using a central device to tune the programming signals is directly contrary to Kurtz’s stated goal of allowing the VCR and television to tune the programming signals. Consequently, no person of ordinary skill in the art would combine Macrae with Kurtz to design a central device that tunes the programming signals.

CONCLUSION

For the foregoing reasons, and the additional reasons set forth in the Appeal Brief, Appellant respectfully requests the Board to overturn the Examiner's rejections of the appealed claims 1-19.

Dated this 26th day of January, 2007.

Respectfully submitted,

WORKMAN NYDEGGER

/ADRIAN J. LEE/

RICK D. NYDEGGER

Registration No. 28,651

ADRIAN J. LEE

Registration No. 42,785

Attorneys for Applicant

Customer No. 047973

CN0000000011V001